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Signed: _____

Cindy Baglietto

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Eric GAUSSIER et. al.)	Group Art Unit: 2161
)	
Application No.: 09/982,236)	Examiner: NGUYEN, Cam Linh T.
)	
Filed: October 19, 2001)	
)	
For: Methods, Systems and Articles of)	Confirmation No.: 7611
Manufacture for Soft Hierarchical)	
Clustering of Co-Occurring Objects)	

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Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the Final Office Action dated August 26, 2005 ("Final Office Action"). This Request is being filed concurrently with a Notice of Appeal.

I. Requirements For Submitting a Pre-Appeal Brief Request for Review

Applicants may request a pre-appeal brief review of rejections set forth in an Office Action if (1) the application has been at least twice rejected; (2) Applicants concurrently file the Request with a Notice of Appeal and prior to an Appeal Brief; and (3) Applicants submit a Pre-Appeal Brief Request for Review that is five (5) or less pages in length and sets forth legal or factual deficiencies in the rejections. See Official Gazette Notice, July 12, 2005.

Applicants have met each of these requirements and therefore request review of the Examiner's rejections in the Final Office Action for the reasons set forth below. The arguments raised below are not a comprehensive set of Applicants' objections to the Final Office Action, and Applicants reserve the right to raise additional arguments on appeal, including arguments that could have been raised here.

Each of the pending independent claims is addressed below. To the extent certain dependent claims are not specifically addressed, Applicants respectfully submit that these dependent claims are allowable for at least the reasons set forth in connection with the corresponding independent claims.

II. The Examiner's Contentions Equating "Teaching Away" with "Non-Analogous Art" are Clearly Erroneous

The Examiner rejected claims 1, 8, 10, 12 —16, and 20 —23 under 35 U.S.C. § 103(a) as allegedly rendered obvious by Francis in view of Aoki. Applicant's arguments that Francis teaches away from the methods described in Aoki have not been correctly addressed by the Examiner. Indeed, the Examiner fails to differentiate between the teaching away argument (advanced by Applicant) from a non-analogous art argument (that was never advanced). See, August 26, 2005, Final Office Action at page 6 §7, where the Examiner declares "In response to Applicant's arguments that the Francis teach[es] away from the invention, which is nonanalogous art"

The Examiner then compounds this error by rejecting the claims on the basis that the non-analogous argument is inapposite because both references allegedly pertain to the same field. See, August 26, 2005, Final Office Action at page 6 §7, where the Examiner asserts that because "[T]he Francis reference is in the same field of the applicant's endeavor. Therefore, the Francis reference [does] not teach away from the Applicant's invention."

Teaching away pertains to proposed modifications that render the prior art unsatisfactory for its intended purpose or that change the principle of operation of a reference. A prior art reference that teaches away from the claimed invention is a significant factor to be considered in determining obviousness. See, M.P.E.P. § 2145 (X)(D) (8th Ed., Rev. 3, Aug. 2005). By equating "teaching away" with "non-analogous art," the Examiner has failed to substantively address Applicant's argument that Francis teaches away from the methods described in Aoki, and made a flawed rejection of the claims based on a non-analogous art argument that was never advanced by Applicant.

III. The Examiner's Argument that Francis and Aoki may be Combined Solely on the Basis that they are in the Field of Applicant's Endeavor and Absent Suggestion or Motivation in the References Themselves is Clearly Erroneous

The Examiner erroneously argues that Francis and Aoki may be combined solely because they are in the field of Applicant's endeavor, and because the Aoki reference allegedly teaches a hierarchical structure of clustered documents.

The Examiner fails to show any teaching or motivation in the references themselves to suggest the combination. Indeed, Examiner's sole basis for combining the references is because "Both the Francis and Aoki references are in the same field of applicant's endeavor (clustering documents). Therefore, the Examiner did not found [sic] any problem to combine the references and yield the present invention." See August 26, 2005, Final Office Action at page 6 §8.

The Examiner's premise that references may be combined solely on the basis that they are in the field of Applicant's endeavor is without foundation and lacking in statutory or case-law support. Therefore, the Examiner's basis for the obviousness rejection is clearly erroneous because the basis for rejection purportedly arises as a consequence of the defective combination of Francis and Aoki.

IV. The Examiner Has Failed to Establish a Prima Facie case of Obviousness

The Examiner has failed to meet the burden of establishing a prima facie case of obviousness. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. See M.P.E.P. §2143 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)).

As Applicant has pointed out in III above, the Examiner's sole basis for combining the Francis and Aoki references was because they were in the field of applicant's endeavor. Therefore, Examiner has failed to establish any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference

teachings, as required by the relevant portions of M.P.E.P. §2143.

Moreover, by failing to substantively address Applicant's arguments that Francis teaches away from the methods described in Aoki, the Examiner has also failed to show that a person of reasonable skill in the art effecting such a combination would have a reasonable expectation of success. Finally, the Examiner has also failed to provide any support to show that the combination of Francis and Aoki would in fact yield the present invention.

Thus, Examiner has clearly failed to meet the burden of establishing a prima facie case of obviousness.


VI. Conclusion

The Examiner's rejection of the pending claims includes clear legal and factual deficiencies, as described in the foregoing arguments. In view of the clear errors in the examiner's rejections, and omissions of one or more essential elements needed to support Examiner's prima facie rejection, Applicants request withdrawal of the rejections directed to claims 1, 8, 10, 12 —16, and 20 —23. Applicants submit further that dependent claims 2-7, 9, 11, and 17-19, are also allowable because they depend from independent claims 1, 8, 10, and 15, respectively. Accordingly, Applicants respectfully request that the rejection of the pending claims be withdrawn and the claims allowed.

Respectfully submitted,

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Dated: November 22, 2005

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